REMARKS

Claims 1-20 are pending in the application. Claims 1, 8, 14, and 17 are independent. By the foregoing Amendment, claims 17-20 have been added. It is believed that these changes introduce no new matter and their entry is respectfully requested.

Rejection of Claims 1-4 and 8-9 Under 35 U.S.C. §102(e)

In the Office Action, the Examiner rejected claims 1-4 and 8-9 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Publication No. 2004/0028099 A1 to Hongo et al. ("Hongo"). A claim is anticipated only if each and every element of the claim is found, either expressly or inherently, in a reference. (MPEP §2131 *citing Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628 (Fed. Cir. 1987)). The identical invention must be shown in as complete detail as is contained in the claim. Id. *citing Richardson v. Suzuki Motor Co.*, 868 F.2d 1226,1236 (Fed. Cir. 1989)). Applicant respectfully traverses the rejection.

Independent claim 1 recites in pertinent part "converting an optical beam emitted from a laser to a current proportional to a power of the optical beam using a monitor photodiode; adjusting the current from the monitor photodiode up or down using a thermistor and resistor network to compensate for a change in ***optical fiber tracking***" (emphasis added). Independent claim 8 recites in pertinent part "first circuitry coupled to receive the current and to adjust the current as temperature changes and to compensate for changes in ***optical fiber tracking***" (emphasis added).

In the Response to Arguments, the Examiner states that "Hongo does not speak of fiber tracking, but his system functions in the same manner. The output of light from the laser diode passes into an EA modulator and then into a fiber ({0036}), which would most certainly be at nearly the same temperature as that of the compensation circuit (due to coupling constraints), and likewise, changes in the fiber tracking would be adjustable based on the fact that the back facet photodiode would have current proportional to the amount of light received by the fiber. For this reason, the examiner agrees that ***Hongo*** does not specifically state that the device is used for fiber tracking, but as the arrangement of parts, and functions, is that of the claimed invention, it ***is believed to inherently make adjustments due to fiber tracking***" (emphasis added). Applicants

respectfully disagree with the Examiner.

To establish inherency, an Examiner must provide rationale or evidence tending to show inherency. MPEP §2112 IV. If relying on extrinsic evidence, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. (MPEP §2112IV *citing In re Oelrich*, 666 F.2d 578, 581-582 (CCPA 1981)). If relying on rationale, an Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the prior art (emphasis in original). (MPEP §2112IV *citing Ex parte Levy*, 17 USPQ.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

It appears that the Examiner is relying on "rationale" to show that it is inherent that the device in Hongo is used for fiber tracking. Applicant respectfully submits that the Examiner's rationale is faulty. Hongo specifically teaches at paragraph [**0075**] "the monitor photodiode 4 in the semiconductor laser module 1 [is used] for controlling the optical output of the semiconductor laser 2 to be constant." Thus, Hongo is quite clear that the function of the monitor PD 4 is to ensure that the output of the laser diode 2 is constant. This is not consistent with the Examiner's contention that "the device [in Hongo] is used for fiber tracking." To the contrary, Applicant's Specification at paragraphs [**0006**] – [**0007**] provide that a "monitor photodiode senses the decrease in the light due to temperature and/or age from the laser and increases the bias current to the laser accordingly... One limitation of this setup is that because of its position ***the monitor photodiode cannot determine how much light is being coupled into the fiber, only what is being output by the laser***... if the amount of light coupled into the optical fiber decreases, due to temperature changes experienced by the optical fiber, mechanical flexures, or aging of laser face coatings, for example, ***the monitor photodiode does not increase the laser bias current to maintain a constant amount of light being coupled into the optical fiber***. As a result, as the temperature increases, the amount of light coupled into the optical fiber decreases" (emphasis added). Thus, it does not necessarily flow from the teachings that Hongo makes adjustments due to fiber tracking as the Examiner asserts. Applicant therefore respectfully submits that the Examiner has failed to meet the burden of showing that it is inherent that the

device in Hongo is used for fiber tracking as recited in claims 1 and 8. Accordingly, Applicant respectfully submits that the Examiner has failed to show where Hongo teaches each and every element of claims 1 and/or 8, either expressly or inherently.

Claims 2-4 and 9 properly depend from claims 1 and 8, respectively, which Applicant submits are patentable. Accordingly, Applicant respectfully submits that claims 2-4 and 9 are patentable for at least the same reason that claims 1 and 8 are patentable. MPEP §2143.03 provides that if an independent claim is unobvious, then any claim depending from the independent claim is unobvious (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). It follows that if an independent claim is patentable over the art of record, then any claim depending from the independent claim is patentable over the art of record. Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claims 1-4 and 8-9.

Rejection of Claims 5-7 Under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claims 5-7 as unpatentable over Hongo in view of U.S. Patent No. 5,812,582 to Gilliland et al. (hereinafter "Gilliland"). To establish a *prima facie* case of obviousness, an Examiner must show that that there is some suggestion or motivation to modify a reference to arrive at the claimed invention, that there is some expectation of success, and that the cited reference teaches each and every element of the claimed invention. (MPEP §2143.) Applicant respectfully traverses the rejection. Claims 5-7 properly depend from claim 1 and as such are patentable over the art of record for at least the same reasons that claim 1 is patentable over the art of record. Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claims 5-7.

Rejection of Claim 10 Under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claim 10 as unpatentable over Hongo in view of U.S. Patent No. 5,383,208 to Queniat et al. (hereinafter "Queniat"). Applicant respectfully traverses the rejection. Claim 10 properly depends from claim 8 and as such is patentable over the art of record for at least the same reasons that claim 8 is patentable over the art of record.

Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claim 10.

Rejection of Claim 11 Under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claim 11 as unpatentable over Hongo in view of Queniat in further view of U.S. Patent No. 6,795,656 B1 to Ikeuchi et al. (hereinafter "Ikeuchi"). Applicant respectfully traverses the rejection. Claim 11 properly depends from claim 8 and as such is patentable over the art of record for at least the same reasons that claim 8 is patentable over the art of record. Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claim 11.

Rejection of Claim 12 Under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claim 12 as unpatentable over Hongo in view of Queniat in further view of U.S. Patent No. 6,055,251 to Ouchi et al. (hereinafter "Ouchi"). Applicant respectfully traverses the rejection. Claim 12 properly depends from claim 8 and as such is patentable over the art of record for at least the same reasons that claim 8 is patentable over the art of record. Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claim 12.

Rejection of Claim 13 Under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claim 13 as unpatentable over Hongo in view of Queniat in further view of Gilliland. Applicant respectfully traverses the rejection. Claim 13 properly depends from claim 8 and as such is patentable over the art of record for at least the same reasons that claim 8 is patentable over the art of record. Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claim 13.

Rejection of Claims 14-16 Under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claims 14-16 as unpatentable over U.S. Patent No. 6,621,621 to Jones et al. (hereinafter "Jones") in view of Hongo. Applicant respectfully traverses the rejection.

Independent claim 14 recites in pertinent part "a transponder having a laser to emit light, a photodiode coupled to receive light from the laser and to convert the light to a current, first circuitry coupled to receive the current and to adjust the current as temperature changes, and second circuitry coupled to receive the adjusted current and to provide the adjusted current to the laser to adjust light emitted by the laser, wherein the first circuitry is further ***to compensate for changes in optical fiber tracking***" (emphasis added).

Applicant reiterates that Hongo specifically teaches at paragraph [**0075**] "the monitor photodiode 4 in the semiconductor laser module 1 [is used] for controlling the optical output of the semiconductor laser 2 to be constant." Thus, Hongo is quite clear that the function of the monitor PD 4 is to ensure that the output of the laser diode 2 is constant. This is not consistent with the Examiner's contention that "the device [in Hongo] is used for fiber tracking." Thus, it does not necessarily flow from the teachings that Hongo makes adjustments due to fiber tracking as the Examiner asserts. Applicant therefore respectfully submits that the Examiner has failed to meet the burden of showing that it is inherent that the device in Hongo is used for fiber tracking as recited in claim 14. Accordingly, Applicant respectfully submits that the Examiner has failed to show where Hongo teaches each and every element of claim 14 either expressly or inherently.

Applicant respectfully submits that Jones fails to make up for the deficiency. Nor does the Examiner assert that Jones teaches of fairly suggests ***circuitry to compensate for changes in optical fiber tracking***. Thus, Applicant respectfully submits that neither Jones nor Hongo alone or in combination teaches or suggests ***circuitry to compensate for changes in optical fiber tracking***. As such, the combination of Jones in view of Hongo fails to teach or suggest each and every element of claim 14 and claim 14 is thus patentable over Jones in view of Hongo. Claims 15-16 properly depend from claim 14 and as such are patentable over Jones in view of Hongo for at least the same reasons that claim 14 is patentable over Jones in view of Hongo. Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claims 14-16.

CONCLUSION

Applicant submits that all grounds for rejection have been properly traversed, accommodated, or rendered moot, and that the application is now in condition for allowance. The Examiner is invited to telephone the undersigned representative if the Examiner believes that an interview might be useful for any reason.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

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on April 20, 2006
Date of Deposit

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